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IN THE

Supreme Court of the United States

OCTOBER TERM, 1973

No. 73-1624

ANDREA DUMON, INC. and BERNARD MALT,
Petitioners,

vs.

CLAIROL, INCORPORATED,
Respondent.

PETITION FOR REHEARING OF DENIAL OF PETITION FOR WRIT OF CERTIORARI TO THE APPELLATE COURT OF ILLINOIS, FIRST DISTRICT

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To The Justices Of The Supreme Court Of The United States:

Petitioners, Andrea Dumon, Inc. and Bernard Malits, respectfully pray for a rehearing of the order denying their petition for a writ of certiorari to review the judgment of the Appellate Court of Illinois, First District,

Clairol, Incorporated v. *Andrea Dumon, Inc.*, 14 Ill. App.3d 641, 303 N.E. 2d 177, 179 USPQ 119 (1973). Said decision so interpreted the common law and statutory law of unfair competition as to restrict competition and deny defendants due process of law (The Illinois Uniform Deceptive Trade Practices Act, Ill. Rev. Stat. 1973 Ch. 121½, Sec. 311).

Within the past three weeks a decision of the Second District of the Illinois Appellate Court (*Filter Dynamics International, Inc.* v. *Astron Battery, Inc.*, 183 USPQ 102 (1974); leave to appeal to the Illinois Supreme Court has been denied) was published*, which interpreted the applicability of said Uniform Deceptive Trade Practices Act diametrically opposite, in many important respects, to the decision of the court here below. This Second District decision in conjunction with the decision of the court below of the First District has intensified the muddled state of the law of unfair competition applicable to uncopyrighted package graphics. We submit that this conflicting decision constitutes substantial intervening circumstances warranting this petition for rehearing under Rule 58(2) of the Rules of the United States Supreme Court.

The petitioners and the business community are entitled to guidelines from this Honorable Court pertaining to the scope of monopoly afforded by the courts to uncopyrighted, unpatented, non-trademark package graphics of consumer goods. The lacuna left by this Honorable Court in 1964 in the cases of *Sears* (*Sears, Roebuck & Co.* v. *Stiffel Co.*, 376 U.S. 224) and *Compco* (*Compco Corp.* v.

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* This decision was published in the Patent Trademark and Copyright Weekly Reports dated October 14, 1974; the instant petition for a writ of certiorari was denied on October 15, 1974.

Daybrite Lighting, Inc., 376 U.S. 234) with respect to competitive use of the same package graphics not monopolized by copyright should now be filled in by specific guidelines by this Court.

The *Clairol* v. *Andrea Dumon* decision below and this recent *Filter Dynamics* decision, *supra*, conflict in two vital areas pertaining to the law of unfair competition, namely, (1) does copying of features of packaging constitute *per se* unfair competition, and (2) is testimony of plaintiff's own witnesses alone sufficient to prove secondary meaning in said graphics, without any evidence of conscious consumer identification of package graphics to producer of product.

(1) The Per Se Rule that Copying Gives Monopoly Rights on the Graphics Copied.

In the *Clairol* decision below, the Court held that proof that defendants copied the graphics of plaintiff's bottle "established" that said bottle graphics had acquired "secondary meaning", stating that defendants did

> "imitate plaintiff's trade dress, and by so doing, they gave truth to plaintiff's claim that its trade dress had acquired secondary meaning." (App. p. 20a)

This affirmed the trial court's conclusion that "uncontradicted proof that the defendants copied the design of plaintiff's bottles and trade dress established their possession of a secondary meaning" (Judge Leighton's opinion of July 10, 1969, App. p. 10a).

Exactly opposite is the decision in the recent *Filter Dynamics* case in which the court held (183 USPQ at p. 109):

> "assuming, as the plaintiffs claim, that defendants did copy the form of plaintiffs' Vu-Pak container, plain-

> tiffs would still not be excused from *establishing by direct evidence* that a secondary meaning had attached to the form alone of their Vu-Pak . . . copying features of plaintiffs' packaging which are not primary determinants of consumer source association of the product *cannot presumptively establish* either likelihood of confusion or *secondary meaning.*" (Italics supplied.)

Thus the *Clairol* decision makes copying *per se* unfair competition; the *Filter Dynamics* decision refuses to do so. It is submitted that rules of fair competition and non-statutory monopoly should be clarified by this Court by reviewing the *Clairol* decision below.

(2) Testimony by Plaintiff's Own Corporate Executives Alone Should Not Be Proof of Secondary Meaning of Package Dress.

The court in the *Clairol* decision below (op. cit.) supported the trial court's conclusion that plaintiff proved secondary meaning as to plaintiff's bottle notwithstanding the court made the following findings of fact part of the record:*

> No. 5. "Plaintiff did not introduce any testimony except that of its Vice President in charge of marketing."
>
> "Plaintiff did not introduce any evidence of consumer confusion or consumer reaction to plaintiff's trade dress."

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* Judge G. N. Leighton's Supplemental Memorandum, No. 66 Ch. 2692, dated June 25, 1970, reproduced in appendix p. 13a, with respect to "Additional Findings of Fact and Conclusions of Law Proposed by Defendants", filed March 3, 1970.

The recent *Filter Dynamics* case holds, on the contrary, that

> "There was testimony by plaintiffs' witnesses that consumers might be confused as to the source or origin of batteries sold in defendants' prototype box. The testimony was not based on actual instances of confusion or consumer surveys, but was the opinions of the witnesses themselves as advertising and marketing experts. The credibility or weight of their testimony in establishing the essential element of likelihood of confusion is subject to discount because they hold important positions with the plaintiffs." (183 USPQ at p. 110)

CONCLUSION

Thirteen states* have adopted the model state law known as the Uniform Deceptive Trade Practices Act. The *Clairol* decision below, in conflict with a decision of a different district in Illinois as well as with the decision in *Mr. Gasket Co.* v. *Travis,* 299 N.E. 2d 906 (Ohio Ct. App. 1973), creates confusion and uncertainty as to the scope of protectability of uncopyrighted package graphics under these states' laws of unfair competition.

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* These 13 states are Colorado, Connecticut, Delaware, Florida, Georgia, Hawaii, Idaho, Illinois, Maine, Nebraska, New Mexico, Ohio and Oklahoma.

Rehearing on the instant petition for a writ of certiorari is respectfully requested.

Respectfully submitted,

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